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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/385,597 08/30/99 PARKER

J 283_205CIP

020874
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SUITE 400
SYRACUSE NY 13202

MM91/0907

EXAMINER

LE.U

ART UNIT

PAPER NUMBER

2876

DATE MAILED:

09/07/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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Office Action Summary

Application No.

09/385,597

Applicant(s)

PARKER ET AL.

Examiner

Uyen-Chau N. Le

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4, 6. 6) ☐ Other:

DETAILED ACTION

Oath/Declaration

1. It does not identify the citizenship of Mr. Andrew Longacre, Jr.
2. Applicant has not given a post office address Mr. Andrew Longacre, Jr. A statement over applicant's signature providing a complete post office address is required.
3. Non-initialed and/or non-dated alterations have been made to the oath or declaration. See 37 CFR 1.52(c).
4. The "date of signature" of Mr. George S. Smith II's is missing from the Oath/Declaration. Please submit a new complete Oath/Declaration in the next communication.

Continuing Domestic Data

5. Acknowledgment is made that this application is a continuation-in-part of Application Serial No. 08/832,020 filed 02 April 1997, which is issued as U.S. Patent No. 5,964,251.

Specification

6. The abstract of the disclosure is objected to because:
Re abstract, line 1: Substitute "The invention relates to an" with -- An --.
Correction is required. See MPEP § 608.01(b).

Claim Objections

7. Claim 9 is objected to because of the following informalities:
Re claim 9, line 8: Substitute "a remote processor" with -- said remote processor --.

Appropriate correction is required.

Obviousness-Type Double Patenting

8. Claims 1 and 9 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 of U.S. Patent No. 5,900,613 (hereinafter '613).

Although the conflicting claims are not identical, they are not patentably distinct from each other because in claims 1 and 9 of the instant application, Applicants claim an **optical** reader comprising, among other things, “an **imaging** assembly”, “a **processor** in communication with said imaging assembly”, “a **memory** in communication with said processor having an **operating program** stored thereon for **controlling operation of said optical reader**”, ... and “said optical reader being adapted to receive a **component control instruction** from a **remote processor**”. The '613 patent discloses an apparatus for scanning and decoding image data encoded in one of a plurality of types of **optically** encoded indicia comprising, among other things, “a read-write random access **memory** space (RAMS) and at least one erasable read only **memory** space (EROMS)”, ... “**scanning means for scanning and storing in said RAMS image data** for said optically encoded indicia”, ... “a plurality of scanning-decoding parameters for **controlling** the scanning and decoding activities of said scanning means and said decoding means”, ... “a **processor** means to **perform tasks corresponding to menu symbols** presented to said apparatus by a user”. Although the scope of claims 1 and 9 of the present application and claims 1-3 of '613 patent are almost identical, the difference between the present claimed invention and the '613 patent is that the present claimed invention is a broader recitation of the '613 patent (e.g., the present claimed invention recite “a **memory** in communication with said

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processor having an operating program stored thereon for controlling operation of said optical reader, etc.” whereby the ‘613 patent recite “a plurality of scanning-decoding parameters for controlling the scanning and decoding activities of said scanning means and said decoding means, etc.”). Thus, with respect to above discussions, It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to use the teaching of claims 1-3 of ‘613 patent as a general teaching for having an operation program stored in a processor to operate the optical reader with the same functions as claimed by the present application. The instant claims obviously encompass the patented claims and differ only in terminology. To the extent that the instant claim is broaden and therefore generic to the patented claims [species], In re Goodman 29 USPQ 2d 2010 CAFC 1993, states that a generic claim cannot be issued without a terminal disclaimer, if a species claim has been previously been patented.

The obviousness-type double patenting rejection is a judicially established doctrine base upon public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from claims in a first patent. In re Vogel, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37 C.F.R § 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R § 1.78(d).

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

10. Claims 1-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Parker et al (US 5,965,863).

Re claims 1-16, Parker et al discloses an optical reader 10 comprising an imaging assembly 30, a processor 42 in communication with the imaging assembly 30, and a memory [45, 46] in communication with the processor 42, the memory 45 having an operating program stored thereon for controlling operation of the optical reader 10, the optical reader 10 is adapted to receive and to execute a component control instruction from a remote processor (local host processor); wherein the component control instruction is a remote trigger 52 activation instruction; wherein the component control instruction is a remote trigger 52 release instruction; wherein the memory stores at least one frame of image data, and wherein execution of the component control instruction results in the at least one frame of image data being uploaded to a remote processor (col. 11, lines 37-56). The imaging assembly 30 includes an illumination source 20, wherein execution of the component control instruction results in the illumination source 20 being controlled. The optical reader 10 further comprising an acoustic output device, wherein execution of the component control instruction results in the acoustic output device being controlled; a display, and wherein execution of the component control instruction results in a predetermined indicia being displayed by the display device; wherein the execution of the component control instruction results in the processor controlling the imaging assembly to capture a frame of image data in the memory (col. 11, lines 23-56 and col. 13, lines 56+). See figs. 1-7; col. 3, line 42 through col. 4, line 58; col. 7, line 47 through col. 11, line 56.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The patents to Hussey et al (US 5,932,862); Ehrhart et al (US 5,929,418); Longacre Jr. et al (US 5,825,006); Imade et al (US 6,129,283); and Spurr (JP 2001-80177) are cited as of interest and illustrate a similar structure to an optical reader system comprising local host processor and optical reader.


12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Uyen-Chau N. Le whose telephone number is 703-306-5588 and email is uyen-chau.le@uspto.gov. The examiner can normally be reached on M-T and TR-F 8:30-7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL G LEE can be reached on (703) 305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-4783 for regular communications and 703-308-7724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.


Uyen-Chau N. Le

September 5, 2001


MICHAEL G. LEE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800